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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/671,927  | 09/26/2003  | Holger Riemer        | 11150/77               | 8298             |
| 26646   | 7590        | 05/18/2006           | EXAMINER               |                  |
| KENYON & KENYON LLP<br>ONE BROADWAY<br>NEW YORK, NY 10004 |             |                      | LARSON, JUSTIN MATTHEW |                  |
|   |             |                      | ART UNIT               | PAPER NUMBER     |
|   |             |                      | 3727                   |                  |

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                               |  |
|------------------------------|-------------------------------|-------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/671,927 | Applicant(s)<br>RIEMER ET AL. |  |
|                              | Examiner<br>Justin M. Larson  | Art Unit<br>3727              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/30/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-13 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copies of the priority documents filed 9/26/03 have been received.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.
3. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14 and 15 are indefinite because it is unclear what bearing is being claimed in claim 14 and what is meant by "end switch" in both of the claims. Regarding the bearing, it is unclear if the bearing is meant to be bearing (12') or ball (10'). Regarding "end switch", since the term "end switch" is not used in the specification, is it not abundantly clear as to what switch Applicant is intending to claim. Examiner regrets not setting forth these issues in the previous Office Action.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  
  
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-4 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoyama et al. (US 5,713,501) in view of Wakefield (US 6,561,489) and LeDuc et al. (US 6,701,913), and further in view of Farmer (US 6,712,171).

Regarding claims 1, 2, 17, and 18 Yokoyama et al. teaches that spare-wheel carriers that pivot about the tailgate region of a motor vehicle are old and well known in the art. Yokoyama et al. fails to teach a sensor that alerts the vehicle operator when the spare-wheel carrier is not in the proper storage position at which point functions of the motor vehicle are blocked until the spare-wheel carrier is placed in the proper storage position.

Now, Wakefield also discloses a spare-wheel carrier for a vehicle where the spare-wheel carrier has a storage position (winched up) and a deployed position (winched down). Wakefield teaches that a sensor is used to alert the vehicle operator via a display unit (9) when the spare-wheel carrier is in the deployed position, the alert continuing until the spare-wheel carrier is returned to the storage position (abstract & claim 6). This alert or warning mechanism decreases the chance that the vehicle operator will drive the vehicle while the spare-wheel carrier is in its deployed position, in which case the spare-wheel would be dragged on the ground underneath the vehicle; certainly a very hazardous situation.

While it can be argued that Wakefield's teachings are not combinable with the carrier of Yokoyama et al. because they are located at different positions on the vehicle, LeDuc et al., like Yokoyama et al., teaches a pivoting carrier at the tailgate region of a vehicle. Although not a spare-tire carrier, LeDuc et al., like Wakefield, teaches that a

sensor may be implemented on the swinging carrier to alert the vehicle operator via a display unit when the carrier is not in a stored or closed position. Again, this serves to reduce the chance that the vehicle operator might drive the vehicle with a carrier swinging freely from the rear of the vehicle; another very hazardous situation.

Considering these three references as described above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a sensor on the pivoting spare-tire carrier of Yokoyama et al., as taught by both Wakefield and LeDuc et al., the sensor activating a display unit, also as taught by both Wakefield and LeDuc et al., in order to reduce the chance that the vehicle operator might drive the vehicle with the spare-tire carrier swinging freely from the rear of the vehicle, preventing a potentially dangerous situation.

This modified Yokoyama et al. spare-wheel carrier still does not have a feature for blocking functions of the motor vehicle in accordance with the position of the spare-wheel carrier. Looking at Farmer, Farmer teaches a sensor mechanism which detects the position of a vehicle's fuel door, determining whether the fuel door is open or closed and in the event that the fuel door is open, the sensor mechanism prevents the engine of the vehicle from starting. In addition to preventing the vehicle operator from running the car while fueling the car, which could ignite the gas fumes, the mechanism also serves to inform the vehicle operator via a display unit that the fuel door is open and prevents the vehicle operator from driving away after forgetting to close the fuel door (col. 2 line 64 – col. 3 line 1). This sensor mechanism takes the sensor systems of Wakefield and LeDuc et al. one step further, as both of their sensor systems intend to

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reduce the chance that the vehicle will be driven in an unsafe condition but do not absolutely prevent the vehicle from being driven, while the sensor system of Farmer does in fact ensure that the vehicle will not be driven in an unsafe condition.

While Farmer never mentions her sensor mechanism being used on a spare-wheel carrier, the sensor mechanism is aimed to prevent the operation of a motor vehicle in an unsafe or hazardous condition based upon the positioning of an exterior vehicle component, just like the sensor mechanism of the modified Yokoyama et al. spare-tire carrier. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement function-blocking capabilities, as taught by Farmer, into the sensor mechanism of the modified Yokoyama et al. spare-wheel carrier in order to increase the effectiveness of the mechanism for preventing the vehicle from being driven in an unsafe or hazardous condition.

Regarding claim 3, because Applicant has not traversed Examiner's assertion of Official Notice, the fact that it is well known to include such display units or indicators along the dashboard, effectively an instrument cluster, so that the display unit or indicator is visibly accessible to the vehicle operator is taken to be admitted prior art.

Regarding claim 4, the spare-wheel carrier of Yokoyama et al. is lockable.

Regarding claim 19, the modified Yokoyama et al. device, in operation, consists of the method steps comprising detecting at least one position of a spare-wheel carrier on a motor vehicle, the spare-wheel carrier pivotable at a body of the motor vehicle and arranged in a region of a tailgate of the motor vehicle; and enabling and blocking functions of the motor vehicle in accordance with the position of the spare-wheel carrier.

***Allowable Subject Matter***

6. Claims 5-13 and 16 are allowed. Claim 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Amendment***

7. In view of Applicant's amendments to the claims filed 1/30/06, the original rejection with respect to the headings, the objection to claim 3, and the original rejections under 35 U.S.C. 112 have been withdrawn.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-4 and 17-19 have been considered but are moot in view of the new ground(s) of rejection. Examiner feels that the new combination and arrangement of references is more supportive of itself, in particular with the addition of the Wakefield reference relating to a spare-wheel carrier.

To the degree that Examiner has maintained a majority of the originally applied references, it is expected that similar arguments to those filed 1/30/06 will again be made. In response to the arguments already made of record, Examiner takes the following positions:

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

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hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, each of Wakefield, LeDuc et al., and Farmer teach a sensor mechanism for alerting a vehicle operator of the position of a component on the vehicle's exterior surface in order to prevent or at least reduce the chance that the vehicle will be operated under hazardous conditions. One of ordinary skill in the art would certainly recognize this common teaching and notice how the references can be applied and used with one another for improving the various safety features of components on exterior surfaces of vehicles.

### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Friday, 8am - 4pm.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JML  
4/26/06

  
NATHAN J. NEWHOUSE  
SUPERVISORY PATENT EXAMINER